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Law Office of Charles Guenzer
PO Box 60729
Palo Alto, CA 94306

In re Application of
Martinez, Celso, Jr.
Application No.: 09/490,740
PCT No.: PCT/BR98/00053
Int. Filing Date: 28 July 1998
Priority Date: 29 July 1997
Attorney Docket No.: 3815.01
For: A ROOF WATERPROOFING SYSTEM
CONSISTING OF AN ORGANIC
RESIN PROTECTED BY AN
ALUMINUM-COPOLYMER
COMPOSITE FOIL

RECONSTRUCTION OF
APPLICATION
UNDER 37 CFR 1.251 AND
PETITIONS UNDER
37 CFR 1.181

This decision is in response to applicant's "Communication," filed with the United States Patent and Trademark Office on 26 September 2003 forwarding copies of application papers for the purpose of reconstructing the above captioned application file and applicant's petition under 37 CFR 1.181 to treat application 09/490,740 as a national stage of PCT/BR98/00053 and applicant's petition under 37 CFR 1.181 filed 13 February 2004. No petition fee is due.

BACKGROUND

On 28 July 1998, applicant filed international application PCT/BR98/00053 claiming a priority date of 29 July 1997. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 11 February 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 18 February 1999, prior to nineteen months from the filing date of the international application. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 31 January 2000 (29 January 2000 was a Saturday).

On 26 September 2003, applicant submitted the instant communication enclosing copies of correspondence that applicant claims to have earlier submitted to the Office along with postcard receipts, to facilitate reconstruction of the file.

DISCUSSION

RECONSTRUCTION UNDER 1.251

Applicant has enclosed a copy of "Reconstruction of File Under 37 CFR §1.251," and a date stamped postcard receipt listing the reconstruction response, a summary of all correspondence, copies of the correspondence and a Notice Under 37 CFR 1.251. The postcard receipt lists the inventor, title and serial number and is date stamped 19 May 2003. Applicant indicates the set of papers is a copy of the 19 May 2003 submission and the statement is signed by someone registered to practice before the Office.

Under 37 CFR 1.251, when applicant is informed that the file cannot be located, applicant can proceed under one of three subsections. Applicant is proceeding under 37 CFR 1.251(a)(1). It requires that applicant furnish a copy of all correspondence, a list of such correspondence, a statement that the copy is a complete and accurate copy of all correspondence between the Office and the applicant for such application, patent or other proceeding, and state whether applicant is aware of any correspondence for such application, patent or other proceeding that is not among applicant's records.

Applicant has furnished a copy of the correspondence, a listing of the correspondence and has furnished the required statements.

REQUEST TO TREAT APPLICATION AS 35 U.S.C. §371 FILING

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. §371(c). The official USPTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

- 1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or
- 2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the described in the identified international application.

The transmittal letter filed on 25 January 2000 clearly identified the application as a §371 filing. There were no conflicting instructions. Accordingly, the instant application should have been treated as the national stage application of PCT/BR/00053.

As the instant application proceeded as a filing under 35 U.S.C. §111(a), the Article 34 amendment and preliminary amendment that accompanied the original filing, which amended the application on the basis of the Article 34 amendment, were never entered. As applicant's subsequent amendment of 15 June 2001 amended the specification and claims as originally filed, rather than as amended under Article 34 and by the preliminary amendment, applicant's 15 June 2001 amendment is

considered an instruction to cancel the Article 34 and preliminary amendments. As such, the Article 34 amendment and the preliminary amendment will not be entered.

Since the application was processed under 35 U.S.C. §111, applicant was charged the fees for an application filed under 35 U.S.C. §111 rather than the fees for an application filed under 35 U.S.C. §371. The fees will be corrected. The additional amount equal to the difference between the basic filing fee under 35 U.S.C. §111 and the basic national fee under 35 U.S.C. §371 will be charged to Deposit Account No. 50-0636.

CONCLUSION

For the reasons discussed above, the Reconstruction Under 37 CFR 1.251 and the petitions under 37 CFR 1.181 are **GRANTED**.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for processing as a U.S. national stage application of the international application no. PCT/BR98/00053, in accordance with this decision, to include mailing of a Notification of Acceptance (Form PCT/DO/EO/903) according to the application date under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) of 25 January 2000. The Article 34 amendment and the preliminary amendment filed 25 January 2000 **SHOULD NOT** be entered. The application should then be forwarded to the reconstruction coordinators in Technology Center 3600 for further processing, including physically entering the 15 June 2001 amendment into the application file and determining whether the accompanying substitute specification was entered and confirming that the claims of record are the allowed claims.



Boris Milef
PCT Legal Examiner
PCT Legal Administration



Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 703-305-0455
Facsimile: 703-308-6459